

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 July 2008 has been entered.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101, which is drafted so as to set forth the statutory classes of invention in the alternative only. See MPEP 2173.05(p). Alternate language such as "adapted to be," "configured to be," etc., should be utilized in lines 2, 9, 11, 13, and 15. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3773

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. Appropriate correction is required (see suggestions above).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Disharoon (4,317,401). Disharoon discloses a vibrating knife (see entire document) comprising an excision member (30) capable of excising a target, wherein the excision member comprises a second edge (38) formed by sides (sides 35 shown in Figure 2) having hydrophilic surfaces (for example, see column 7, lines 34-35; both surfaces adjacent to the edge 38 may be rendered hydrophilic), and a first edge (not shown in Figure 2, but is considered the edge formed directly opposite of edge 38) formed by sides having a hydrophobic surface (not shown in Figure 2, but are considered sides directly opposite of illustrated sides 35) in that the excision member is formed from a hydrophobic material (for example, see column 7, lines 31-32). Disharoon's device

satisfies the claimed structural limitations and the edges are capable of performing the functions as claimed.

Claim 2 is being treated as a product by process limitation, in that "the hydrophobic surfaces and the hydrophilic surfaces are respectively formed by coating" refers to the process of forming the surfaces and not to the final product created. As set forth in MPEP 2113, "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695,698,227 USPQ 964,966 (Fed. Cir. 1985). Examiner has evaluated the product claim without giving much weight to the method of its manufacture. Therefore, in this case, hydrophobic surface and hydrophilic surface as described above wherein the surfaces are formed by coating is directed to the method of making the surfaces and not to the final product made. It appears that the product disclosed by Disharoon would be the same as that claimed; especially since both applicant's product and the prior art product have the same final structure of an excision member comprising edges formed by sides having hydrophobic and hydrophilic surfaces.

### ***Response to Arguments***

Applicant's arguments filed 18 July 2008 have been fully considered but they are not persuasive. Applicant argues that the prior art applied fails to disclose each and every element as claimed. Examiner respectfully disagrees.

Applicant argues that Disharoon discloses only one cutting edge (38), therefore, fails to disclose or suggest a first edge and a second edge. However, Disharoon discloses the excision member (30) comprises parallel surfaces (32 and 33) having four substantially planar portions (35) extending perpendicular from and between the parallel surfaces (32 and 33). Therefore, although not shown in Figure 2, it is the examiner's position that Disharoon inherently suggests four edges (i.e., the four corners of the excision member), wherein the second edge is considered to be edge 38 and the first edge is considered to be the edge formed directly opposite of edge 38. Disharoon discloses the surfaces (35) adjacent the second edge (38) may be rendered hydrophilic, thus the second edge is formed by sides having hydrophilic surfaces. Disharoon further discloses the excision member is hydrophobic, thus the first edge is formed by sides having hydrophobic surfaces.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Thursday 8:30-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./  
Examiner, Art Unit 3773  
September 24, 2008

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773